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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,617	10/25/2001	Shell S. Simpson	10007679-1	3072

7590 06/27/2007  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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THOMAS, ASHISH

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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06/27/2007

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/052,617  
Filing Date: October 25, 2001  
Appellant(s): SIMPSON, SHELL S.

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David R. Risley  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 27, 2007 appealing from the Office action mailed on October 16, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Applicant's admitted prior  
art in the background

5,726,897	Tammi	3-1998
5,091,777	Gleason	2-1992
5,745,590	Pollard	4-1998
6,714,964	Stewart	3-2004

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-7, 12-15, 18-19, 21, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi(US patent 5,726,897) in view of Gleason(US patent 5,091,777).

Regarding claim 1, Tammi discloses a method for print-to-mail notification, comprising:

determining that a print-to-mail format document has been printed, folded, and sealed as a mailing (column 4, lines 27-42 and column 10, lines 4-35);

generating notification information that identifies that the print-to-mail format document has been printed, folded, and sealed as a mailing (column 4, lines 27-42).

Post processing includes folding and sealing as disclosed in column 7, lines 15-27. Also note that described in column 10, lines 4-35 is a method that detects if post processes such as folding and sealing have been accomplished by the post processing system 70; this references specifically indicates that the completion of post processes such as folding and sealing are communicated. Tammi discloses in column 4, lines 40- 42 that

post processing means can also verify receipt and matching of printed statement. Verifying receipt of document is considered equivalent to generating notification information.

However, Tammi does not disclose the step of identifying attributes of the print-to-mail format document.

Gleason discloses the above limitation in column 5, lines 27-30.

Tammi and Gleason are combinable because they are from the same field of endeavor that is document assembly for mailing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to identify the attributes of the print-to-mail document.

The suggestion/motivation for doing so would have been to correlate a mailing with a specific recipient.

Therefore, it would have been obvious to combine Tammi and Gleason to obtain the invention as specified in claim 1.

Regarding claim 2, Tammi discloses the method of claim 1, wherein determining that a print-to-mail format document has been generated comprises detecting that the print-to-mail document has been printed, folded, and sealed(column 4, lines 40-42 and column 10, lines 4-35).

Regarding claim 3, Tammi discloses the method of claim 1, wherein determining that a print-to-mail format document has been generated comprises receiving a notice from a print-to-mail device component configured to fold and seal the document (column 4, lines 40-42 and column 10, lines 4-35).

Regarding claim 4, Gleason discloses the method identifying document of claim 1 wherein attributes comprises identifying at least one of a name of the document, a date the document was printed, and a name of a user (column 5, lines 28-30).

Regarding claim 5, Gleason discloses the method of claim 1, wherein identifying document attributes comprises identifying at least one of a customer name, a customer number, a billing period to which the document pertains (column 5, lines 28-30).

Regarding claim 6, Gleason discloses the method of claim 1, wherein generating notification information comprises generating notification information that identifies at least one of the document attributes (column 5, lines 21-30).

Regarding claim 7, Tammi discloses the method of claim 1, further comprising transmitting notification information to a computing device(column 4, lines 52-60).

Regarding claim 19, Tammi discloses the device of claim 18, wherein the hard copy generation hardware comprises a print engine (printer 30).

Regarding claim 26, Gleason discloses the device of claim 21, wherein the at least one attribute comprises at least one of a name of the document, a date the document was printed, and a name of a user (column 5, lines 28-30).

2. Claims 8-10, 16, 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi(US patent 5,726,897) in view of Gleason(US patent 5,091,777) and further in view of Stewart(US patent number 6,717,964).

Regarding claim 8, Tammi and Gleason fail to disclose the method of claim 7, wherein transmitting notification information comprises transmitting notification information to a remote computing device via a network.

However, Stewart discloses this limitation in abstract.

Tammi, Gleason, and Stewart are combinable because they are from the same field of endeavor that is printing services.

At the time of the invention, it would have been obvious to a person ordinary skill in the art to store notification information in a remote computing device (web server).

The suggestion/motivation for doing so would have been to enable a user to view images remotely.

Therefore, it would have been obvious to combine Tammi, Gleason, and Stewart to obtain the invention as specified in claim 8.

Regarding claim 9, Stewart discloses the method of claim 7, wherein transmitting notification information comprises transmitting the information to a database from which data contained within the print-to-mail format document originated (abstract).

Regarding claim 10, Tammi does not disclose the method of claim 9, wherein the database is supported by a network-based database management system. It is well known that data bases in a network are supported by network-based database management system.

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Regarding claim 24, Stewart discloses the device of claim 18, further comprising an embedded web server that supports a print-to-mail service that is accessible over a network (column 2, line 33).

Regarding claim 25, Stewart discloses the device of claim 24, wherein the service comprises a print-to-mail web service that is accessible over the Internet (column 2, line 33).

3. Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi (US patent 5,726,897) in view of Gleason (US patent 5,091,777) and further in view of Pollard(US Patent 5,745,590).

Regarding claim 11, Tammi in view of Gleason do not disclose the method of claim 1, further comprising storing the notification information within memory of a print-to-mail device that printed, folded, and sealed the print-to-mail format document.

However, Pollard discloses in column 5, lines 29-37 memory 34 for storing information regarding diverted mail pieces.

Tammi, Gleason and Pollard are combinable because they are from the same field of endeavor that is document assembly for mailing.

At the time of the invention, it would have been obvious to a person ordinary skill in the art to store notification information within the memory.

The suggestion/motivation for doing so would have been to establish a reprint file.



Therefore, it would have been obvious to combine Tammi, Gleason and Pollard to obtain the invention as specified in claim 11.

4. Claims 28, 29, 30, 31, 32, 33, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi (US patent 5,726,897) in view of Gleason (US patent 5,091,777), Pollard (US Patent 5,745,590), and the Applicant's admitted prior art.

Regarding claims 28, 33, 34, and 35, Tammi, Gleason, and Pollard does not explicitly state that the print-to-mail format document does not require an envelope for purposes of mailing once it has been folded and sealed as a mailing.

Page 1, lines 14-20 of the current application's specification discuss known prior art wherein a bill is sealed and folded, an envelope is not used here.

Therefore, it would have been obvious for one of ordinary skill in the art to modify Tammi, Gleason, and Pollard with the admitted prior art to come up with a method wherein the print-to-mail format document does not require an envelope.

The motivation for this combination is that it enables a printed media to be mailed as opposed to putting the printed media on an envelope and then mailing it; an envelope is not needed to mail something.

Regarding claim 29, Tammi discloses the device of claim 28, wherein the recipients are customers of a business and the mailings comprise bills that are to be mailed to the customers (column 1, lines 20-38).

5. Analogous Claims.

Regarding claim 12, arguments analogous to those presented for claim 1 are presented.

Regarding claims 13 and 21, arguments analogous to those presented for claim 4 are presented.

Regarding claims 14 and 27, arguments analogous to those presented for claim 5 are presented.

Regarding claim 15, arguments analogous to those presented for claim 7 are presented.

Regarding claims 16, 23, 31, arguments analogous to those presented for claim 8 are presented.

Regarding claim 17, arguments analogous to those presented for claim 11 are presented.

Regarding claim 18, arguments analogous to those presented for claim 1 are presented.

Regarding claims 32, arguments analogous to those presented for claim 1 and 11 are presented.

Regarding claim 22, 30, arguments analogous to those presented for claim 9 are presented.

#### **(10) Response to Argument**

In response to the Appellant's arguments, the examiner respectfully disagrees that the rejection should be reversed. Only those arguments raised by the appellant pursuant to the particular issues on appeal have been considered and addressed by the examiner.

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Any further arguments regarding particular limitations not specifically argued or other reasoning regarding deficiencies in a prima facie case of obviousness that the appellant could have made are considered as having been conceded by the appellant for the basis of the decision of this appeal and are not being subsequently addressed by the examiner for the Board's consideration. Should the panel find that the examiner's position/arguments or any aspect of the rejection is not sufficiently clear or a particular issue is of need of further explanation, it is respectfully requested that the case be remanded to the examiner for further explanation prior to the rendering of a decision

**A. Rejection of Claims 1-7, 12-15, 18, 21, 26-29, and 32**

**1. Claims 1-7 and 12-15**

In page 10 of the Appeal Brief, the Appellant argues that the Tammi reference does not teach "determining that a print-to-mail format document has been generated by printing, folding, and sealing the document as a mailing." The Appellant further asserts that "Tammi instead only teaches determining that printed sheets of mailing statements have entered a post processing system." And "Tammi describes no determination that folding and/or sealing later occurred."

In response, the Examiner respectfully asserts that the Tammi reference can determine if folding and/or sealing later occurred. Please note that column 9, lines 44-59 teach a post processing system 70 that consists of a folder 80 and a sealing apparatus 90. Furthermore, column 10, lines 4-35 disclose the ability to sense post processing operations such as folding and sealing. In fact, in column 10, lines 10-15, Tammi succinctly states that the position or location of the printed mail statements are

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tracked. So by tracking, the position of a printed mail statement in the post processing system 70 is constantly monitored. For example, the printed statement can be monitored when it enters a folder 80 and when it exits folder 80 to another processor.

And the same can be said for the sealing process as well. The ability to track a printed statement enables Tammi to monitor the status of that statement, whether it is entering a processor or exiting it. By monitoring the position of the printed mail statement, at some point in time, a determination must be made to see if it has exited a processor such as the folder 80 or sealing apparatus 90. After all, if such a determination cannot be realized, then there is no point to the tracking method stated in the Tammi reference.

All this firmly establishes that the Tammi reference can indeed determine that a print-to-mail format document has been generated by printing, folding, and sealing the document as a mailing.

In pages 10 and 11 of the Appeal Brief, the Appellant argues that Tammi does not teach or suggest "generating notification information that identifies that the print-to-mail format document has been generated, thereby indicating that that the document has been printed, folded, and sealed as a mailing." The Appellant goes on to assert that Tammi "only receives signals in regard to the entry of the printed sheets into the post processing system, not as to any folding and/or sealing operations."

In response, the Examiner respectfully disagrees with these assertions as well. First of all, the current wording of claims 1 and 12 needs to be noted. These two claims discuss a method and means for "generating notification information." The term "notification information" can be interpreted in many ways. For example, it can be

interrupted as a communication that indicates the document has been printed, folded, and sealed. And in column 10, lines 4-35, such a communication is disclosed by Tammi. Especially in column 10, lines 10-15, Tammi teaches a method that tracks the location or position of a printed mail statement in relation to devices such as folder 80 and sealing apparatus 90 in the post processing system. In order to actually keep track of the status of the printed mail statement, the sensed or determined status of the statement needs to be communicated to the tracking means. This communication is one example of "generating notification information." If status information is not communicated to the tracking means, then it cannot legitimately track the status of the printed mail statement.

In pages 12 and 13 of the Appeal Brief, the Appellant states that "Tammi only discloses 'sensing means' of the post processing system that track the machine cycles of the system. Nowhere is it stated that any determination of whether a print-to-mail format document was generated is actually made."

In response, this is a false assertion. First of all, sensing the position of a printed mail statement is the same as determining the position of a printed mail statement. Secondly, column 9, lines 44-59 detail the actual order of the post processing operations. The printed mail statement is first transferred to a collator 75, then to buckle folder 80, inserter apparatus 85, wetting and sealing apparatus 90, and finally to metering device 95. And column 10, lines 4-35 detail the ability to keep track of the exact position of the printed mail statement as it is transferred to each of the devices in the post processing system. So when the printed mail statement is at sealing apparatus

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90, it is sensed and tracked that the printed mail statement has been folded already. Similarly, when the printed mail statement is at metering device 95, it is sensed and tracked that the statement has been folded and sealed. It follows that when the printed mail statement is transferred from the sealing apparatus 90, it is determined that a folded and sealed document was generated.

In pages 13 and 14 of the Appeal Brief, the Appellant cites that the Tammi reference fails to meet the definition of "print-to-mail format document" as specified in the Specification.

In response to Appellant's argument that the Tammi reference fails to show certain features of appellant's invention, it is noted that the features upon which appellant's relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Based on the wording of claims 1 and 12, the printed mail statements found in the Tammi reference read on the "print-to-mail format document" cited in these claims since the printed statements are processed and subsequently mailed out; that can be categorized as a "print-to-mail format." Please note that claims 1 and 12 fail to divulge that the "print-to-mail format" is a format wherein the document can be mailed without the need of an envelope. In view of this, the current rejection of claims 1 and 12 using the Tammi reference is justified. On the other hand, claims 33-35 actually do divulge the definition of a "print-to-mail format" as stated in the Specification, and accordingly those claims are rejected differently.

In page 15, paragraph 3 and page 16, paragraph 1 of the Appeal Brief, the Appellant contends that "Tammi does not describe any notifications **after** the printed mail statements are placed in envelopes and sealed in them."

In response, the Examiner cannot agree with the Appellant's remarks. Column 9, lines 44-59 illustrate that once the printed mail statements are placed in the envelopes and sealed in them, they are transferred to a postage metering device 95. Meanwhile, column 10, lines 4-35 teach that the position of the printed mail statements are monitored and communicated to a tracking means as they go through all the devices in the post processing system 70. It follows that as soon as the sealed envelope containing the printed mail statement is transferred from the sealing apparatus 90 to the postage metering device 95, this transfer is communicated to the tracking means. And this communication is an example of the notification which is done **after** the mail statements are placed in envelopes and sealed in them. It seems as though the sole basis for the Appellant's argument here is based on the fact that Tammi does not divulge a "print-to-mail format document" as described in the Specification. But the Examiner would like to re-iterate that a broad interpretation of the claim language is employed since both claims 1 and 12 fail to include the definition of "print-to-mail format document" as stated in the Specification.

**2. Claims 18, 21, 26-29, and 32**

In page 17 of the Appeal Brief, the Appellant claims that "Tammi does not teach a print-to-mail notifier configured to generate notification information pertinent to 'generating of print-to-mail documents that have been printed, folded, and sealed by the

print-to-mail device as a mailing.’ Tammi’s system controller only receives signal in regard to entry of printed sheets into the post processing system, not as to any folding and/or sealing operations.”

In response, the Examiner respectfully disagrees with these assertions as well. First of all, the current wording of claims 18 and 28 needs to be noted. These two claims discuss a device that can “generate notification information.” The term “notification information” can be interrupted in many ways. For example, it can be interrupted as a communication that indicates the document has been printed, folded, and sealed. And in column 10, lines 4-35, such a communication is disclosed by Tammi. Especially in column 10, lines 10-15, Tammi teaches a method that tracks the location or position of multiple printed mail statement in relation to devices such as folder 80 and sealing apparatus 90 in the post processing system. In order to actually keep track of the status of the printed mail statements, the sensed or determined status of the statements needs to be communicated to the tracking means. This communication is one way to “generate notification information.” If status information is not communicated to the tracking means, then it cannot legitimately track the status of the multiple printed mail statements.

**(11) Related Proceeding(s) Appendix**



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No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ashish K. Thomas


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